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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Proceeding | 85785304 |
| Applicant | Transamerica Corporation |
| Applied for Mark | TRANSAMERICA RETIREMENT SOLUTIONS |
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| Date | 02/05/2014 |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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| Applicant | : | Transamerica Corporation |
| Serial Nos. | : | 85/785,297<br>85/785,304 |
| Mark | : | **TRANSAMERICA RETIREMENT SOLUTIONS** |

# APPLICANT'S APPEAL BRIEF

Applicant submits the following points and authorities in support of its appeal.

## I. Statement of the Case

Applicant Transamerica Corporation seeks registration of TRANSAMERICA RETIREMENT SOLUTIONS in connection with the following services:

> Class 35: Outsourcing in the field of retirement plan administration, namely, financial record keeping, records management, notices to participants, distribution processing, payroll consolidation, and monitoring of eligibility dates, providing an on-line computer website that provides commercial financial transaction data, account management, financial reporting, accounting features and related reference information; preparation of reports relating to finance and investments provided via various means, which may include but are not limited to, the Internet, global networks, telephone, and facsimile (U.S. Ser. No. 85/785,297); and
>
> Class 36: Financial services, namely, underwriting and distribution of life and health insurance and annuity products; investment management and advisory services; mutual fund management, brokerage, and distribution services; retail stock brokerage services; financial retirement planning; administration of retirement and pension plans; and insurance agency and brokerage services (U.S. Ser. No. 85/785,304).

The Examining Attorney has required Applicant to disclaim the wording "RETIREMENT SOLUTIONS" on the ground that it "merely describes a feature of Applicant's services." *See* March 15, 2013 Office Action. As the owner of a prior incontestable registration including this wording for materially identical services, Applicant is not subject to the disclaimer requirement pursuant to the Trademark Rules of Practice and precedential case law. The

Examining Attorney's disregard of Applicant's prior incontestable registration is clearly erroneous under *In re American Sail Training Ass'n*, 230 USPQ 879 (TTAB 1986).

## II. Argument

Applicant's mark, TRANSAMERICA RETIREMENT SOLUTIONS, is the culmination of a business combination between Applicant's wholly owned subsidiaries, Transamerica Retirement Corp. and Diversified Retirement Corp., following upon 20-plus years of substantial and continuous use of PARTNERS IN RETIREMENT SOLUTIONS by Diversified Retirement Corp. and its predecessors, and 19 years of substantial and continuous use of ALTERNATIVE RETIREMENT SOLUTIONS by Applicant's wholly owned subsidiary, Western Reserve Life Assurance Company of Ohio. One of those two marks, ALTERNATIVE RETIREMENT SOLUTIONS, is the subject of a prior incontestable registration for substantially identical services.

Applicant, through its wholly-owned subsidiaries, owns two federal service mark registrations incorporating the wording "RETIREMENT SOLUTIONS":

(1) ALTERNATIVE RETIREMENT SOLUTIONS, U.S. Registration No. 2,036,473, registered February 11, 1997, for "financial services, namely the underwriting and administering of life insurance, variable life insurance, variable annuities and fixed annuities," in International Class 36, registered February 11, 1997 (first use January 7, 1995); and

(2) PARTNERS IN RETIREMENT SOLUTIONS, U.S. Registration No. 4,390,350, registered August 27, 2013, for "fund investment services; financial administration of employer retirement plans, employee benefit plans, employee pension plans and employee pension investments; investment management services; financial services, namely, retirement planning services; providing others, including retirement plan advisors, plan sponsors and plan participants, with educational information and other information in the fields of financial planning and investing for retirement; investment management and administration of tax deferred annuity plans; financial information and financial planning services; investment management and administration of defined contribution plans, defined benefit plans and money purchase plans, profit sharing plans, 457 plans, cash balance plans, pension equity plans, Taft-Hartley and non-qualified deferred compensation plans and individual retirement accounts; all of the

> foregoing provided via various means, which may include but are not limited to, the Internet, global networks, telephone, and facsimile, and to various organizations, which may include but are not limited to, corporations, governmental organizations, educational institutions, hospitals, foundations, not-for-profit organizations, and healthcare organizations" in International Class 36, registered August 27, 2013 (first use November 15, 1993).

Applicant's incontestable registration for ALTERNATIVE RETIREMENT SOLUTIONS includes a disclaimer for the term "RETIREMENT" only. The U.S. Patent and Trademark Office ("PTO") recently registered Applicant's PARTNERS IN RETIREMENT SOLUTIONS mark without any disclaimer.

Pursuant to Rule 2.41(b) of the Trademark Rules of Practice, Applicant's ownership of these marks, which identify materially identical services, requires the PTO to recognize the *prima facie* distinctiveness of the wording "RETIREMENT SOLUTIONS." 37 C.F.R. § 2.41(b).

In the alternative, Applicant respectfully requests that the TRANSAMERICA RETIREMENT SOLUTIONS applications be permitted to register without a disclaimer based on the acquired distinctiveness of the wording "RETIREMENT SOLUTIONS" in view of its use of the phrase with materially identical services for over 20 years.

**A. Prior Registrations**

Rule 2.41(b) of the Trademark Rules of Practice provides that "[i]n appropriate cases, ownership of one or more prior registrations on the Principal Register . . . may be accepted as *prima facie* evidence of distinctiveness." As noted above, Applicant, through its wholly owned subsidiaries, owns a prior registration for PARTNERS IN RETIREMENT SOLUTIONS without any disclaimer, and an incontestable registration for ALTERNATIVE RETIREMENT SOLUTIONS with a disclaimer of "RETIREMENT" only. Applicant's prior registrations constitute the "same mark" as TRANSAMERICA RETIREMENT SOLUTIONS for purposes of Rule 2.41(b). Within the marks, the words RETIREMENT SOLUTIONS are the "legal

equivalent." A mark is the legal equivalent of another if it creates the same, continuing commercial impression such that the consumer would consider them both the same mark. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001). *See also Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 6 USPQ2d 1475, 1477 (TTAB 1988); *In re Best Products Co., Inc.*, 231 USPQ 988, 989 n.6 (TTAB 1986) (differences between BEST & Design and BEST JEWELRY & Design, and between identifications of services, held immaterial); *In re Loew's Theatres, Inc*., 223 USPQ 513, 514 n.5 (TTAB 1984), *aff'd*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (minor difference in marks held improper basis for exclusion of evidence under rule); *In re Flex-O-Glass, Inc.*, 194 USPQ 203, 205-06 (TTAB 1977) ("[P]ersons exposed to applicant's registered mark ... would, upon encountering [applicant's yellow rectangle and red circle design] ..., be likely to accept it as the same mark or as an inconsequential modification or modernization thereof.... [A]pplicant may 'tack on' to its use of the mark in question, the use of the registered mark ... and therefore may properly rely upon its registration in support of its claim of distinctiveness herein."); *accord, Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991).

Rule 2.41(b) is additionally applicable because the services in Applicant's prior registrations are materially the same as those in the present applications. The prior registrations and applications all cover services in the finance field, and are materially similar for the purposes of finding the distinctiveness of the wording "RETIREMENT SOLUTIONS." The Examining Attorney failed to recognize these registrations and the services identified therein, contrary to the authority requiring an examination of such services. "The Examining Attorney should determine whether the goods or services named in the application are sufficiently similar to the goods or services named in the prior registration(s)." Trademark Manual of Examining Procedure

§ 1212.04(c); *In re Best Products Co., Inc.*, 231 USPQ at 989 (holding mail order and catalog showroom services sufficiently similar to retail jewelry store services for application of rule); *In re Owens-Illinois Glass Co.*, 143 USPQ 431, 432 (TTAB 1964) (cut-glass articles held materially similar to plastic tableware for purposes of rule); *In re Lytle Engineering & Mfg. Co.*, 125 USPQ 308, 309 (TTAB 1960) (planning, preparation and production of technical publications held sufficiently similar to brochures and catalogues for application of rule).

At a bare minimum, the requirement for a disclaimer of the word "SOLUTIONS" must be withdrawn, even if the requirement is maintained for the word "RETIREMENT," because requiring the disclaimer of the word "SOLUTIONS" would constitute a collateral attack on Applicant's prior incontestable registration of ALTERNATIVE RETIREMENT SOLUTIONS. *See In re American Sail Training Ass'n*, 230 USPQ 879 (TTAB 1986).

In *American Sail Training Ass'n*, the TTAB held that an Examining Attorney could not require a disclaimer of "tall ships" in an application for registration of RETURN OF THE TALL SHIPS, where the Applicant owned a prior incontestable registration for the mark TALL SHIPS in connection with the same services. To permit otherwise, the Board held, would result in a collateral attack on the incontestable registration on a ground that could not be raised by any competitor or any other party, and thus could not be raised in an *ex parte* proceeding. *Accord, In re Best Software Inc.*, 63 USPQ2d 1109, 1113 (TTAB 2002). Under the rule of *American Sail Training Ass'n*, the Examining Attorney's requirement for a disclaimer of the word SOLUTIONS is a reversible error, even if the disclaimer of RETIREMENT is otherwise sustained.

### B. Acquired Distinctiveness

Pleading in the alternative, Applicant submits that the wording "RETIREMENT SOLUTIONS" has acquired distinctiveness resulting from continuous and substantial use by Applicant's predecessors as all or part of a service mark since at least as early as November 15, 1993. As stated above, the genesis of the TRANSAMERICA RETIREMENT SOLUTIONS trade name and service mark was the combination between Applicant's wholly owned subsidiaries, Transamerica Retirement Corp. and Diversified Retirement Corp. At the time of the combination, Diversified Retirement Corp. had been using DIVERSIFIED RETIREMENT SOLUTIONS as a corporate trade name since 2006-2007 in the form of subsidiaries in Florida, Wisconsin and Texas. *See* Exhibit C to Applicant's December 5, 2013 Request for Reconsideration. Further, Applicant's registered ALTERNATIVE RETIREMENT SOLUTIONS and PARTNERS IN RETIREMENT SOLUTIONS marks have been in use since 1995 and 1993, respectively.

Such continuous and substantial use constitutes an independent ground to withdraw the disclaimer requirement in this case and/or augments the evidentiary weight of the prior registrations of ALTERNATIVE RETIREMENT SOLUTIONS and PARTNERS IN RETIREMENT SOLUTIONS.

## III. Conclusion

The Examining Attorney erred in requiring a disclaimer of "RETIREMENT SOLUTIONS." Trademark Rule 2.41(b) is intended to promote consistency and certainty for trademark owners attempting to register marks that have previously been deemed distinctive, or that have acquired distinctiveness through long-term use. The Examining Attorney's failure to consider Applicant's prior registrations, as well as Applicant's long-term use of the wording

"RETIREMENT SOLUTIONS," is contrary to the Rules of Trademark Practice and TTAB authority. The disclaimer requirement must be reversed, at least as to the word SOLUTIONS, and the TRANSAMERICA RETIREMENT SOLUTIONS applications should be allowed to proceed to publication.

Respectfully submitted,

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